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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,136	01/12/2001	Stephen Nuss	990356.ORI	2264

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 12/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/760,136

Applicant(s)

NUSS, STEPHEN

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The finality of the Office Action dated 4/22/03 has been withdrawn in view of the new rejections under 35 USC § 102 and 35 USC § 103 applied to previously allowed subject matter.

#### *Claim Objections*

1. Claims 18 and 26 are objected to because of the term “for making the guidewire slipperier”.

It is unclear what the guidewire is more slippery than; there is no reference for the slipperiness of the guidewire.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 12 and 20 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,817,600 to Herms et al.

In regards to claims 12 and 20, Herms et al. discloses applicant's claimed invention including a titanium molybdenum alloy wire having approximately 78% titanium, 11.5% molybdenum, 6% zirconium and 4.5% tin by weight (Col. 4, lines 37 – 45).

3. Claims 12 and 20 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0009215 to Mayer.

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In regards to claims 12 and 20, Mayer discloses applicant's claimed invention including a titanium molybdenum alloy wire having approximately 78% titanium, 11.5% molybdenum, 6% zirconium and 4.5% tin by weight [0078].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,132,389 to Cornish et al. in view of U.S. Patent Application Publication No. 2003/0009215 to Mayer.

In regards to claims 12 – 27, Cornish et al. discloses a guidewire comprising a titanium alloy wire having a proximal end and a distal end, the distal end having a smaller diameter than the proximal end; a taper of the diameter between the distal end and the proximal end with the distal end being smaller (Col. 3, line 66 – Col. 4, line 14); a coil (20) attached to the distal end; a distal tip (58) on the distal end; a polymer coating and a hydrophilic coating (Col. 3, lines 50 – 60). Cornish et al. discloses the wire being formed of any suitable material (Col. 3, lines 42 – 47). However, Cornish et al. fails to disclose the titanium alloy being a titanium molybdenum alloy having approximately 78% titanium, 11.5% molybdenum, 6% zirconium and 4.5% tin by weight. Mayer discloses a medical device for inserting into body passageways during medical procedures including a titanium molybdenum alloy wire having approximately 78% titanium, 11.5% molybdenum, 6% zirconium and 4.5% tin by weight [0078]. It would have been obvious to one having ordinary skill in the art at the

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time the invention was made to modify the titanium alloy as disclosed by Cornish et al. to include a titanium molybdenum alloy as taught by Mayer in order to avoid undue irritation to patients having a sensitivity to nickel [0079]. Additionally, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Lesbin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,402,859 to Ishii et al. and U.S. Patent Application Publication No. 2003/0009095 to Skarda.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703)-305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (703)308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9306 for regular communications and (703)-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.

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JMLF  
December 19, 2003

  
MAX F. HINDENBURG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700